

REMARKS

- Claims **16, 19, 23, and 25-27** were pending in the present application
- Claims **16, 19, 23, and 25** stand rejected
- Claims **26-27** were not examined

Upon entry of this amendment, which is respectfully requested for the reasons set forth below:

- Claims **16, 19, 23, and 25-44** will be pending
- Claims **16 and 19** will be amended
- Claims **28-44** will be added
- Claims **16, 19, 23, and 25-26** will be the only independent claims

Claims 26-27 Have Not Been Examined

During a telephone conversation held on October 7, 2002, with the Examiner, the Examiner confirmed that Claims **26-27** are pending but have not yet been examined.

As Applicants explained to the Examiner, a Preliminary Amendment filed on April 3, 2000, concurrently with the present application, mistakenly purported to cancel Claims 26-27. Only Claims 1-25, however, were in the application before the entry of the Preliminary Amendment.

In a Second Preliminary Amendment filed on April 10, 2001, Applicants added new Claims **26-27**. Following the Second Preliminary Amendment and prior to the entry of this Amendment, Claims **16, 19, 23, and 25-27** were pending. Claims **16, 19, 23, 25, and 26** are independent.

Applicants respectfully request the Examiner's consideration of Claims **26-27**.

Specification Amendment

The Specification has been amended to correct a minor and obvious typographical error noted during a review of the file. Specifically, a recited reference to step "908" has been replaced correctly with a reference to step "907." No new matter has been added by this amendment, and no amendment was made for any reason related to patentability.

Claim Amendments

Claims **16 and 19** have been amended to correct minor and obvious typographical errors noted during a review of the file. Specifically, occurrences of "financial account identifier" have been replaced correctly with "account identifier." No new matter has been added by this amendment, and no amendment was made for any reason related to patentability.

Double Patenting Rejection

Claims **16, 19, 23 and 25** stand “rejected under the judicially created doctrine of obviousness-type double patenting” as being unpatentable over specified claims of U.S. Patent No. 6,163,771. Applicants do not agree with this rejection.

During a telephone conversation held on August 13, 2002, the Examiner explained that the obviousness-type double patenting rejection of Claims **16 and 19** has been withdrawn. Accordingly, the double patenting rejection of Claims **16 and 19** is moot. Applicants are grateful for the Examiner’s re-consideration of Claims **16 and 19**.

Applicants respectfully submit that the asserted double patenting rejection of Claims **16, 19, 23 and 25** is improper because the Patent and Trademark Office previously made a requirement of restriction to the invention in the claims of U.S. Patent Application No. 08/919,339, which issued as U.S. Patent No. 6,163,771. Each of pending Claims **16, 19, 23, 25, and 26-27** is consistent with the non-elected claimed subject matter of U.S. Patent Application No. 08/919,339 that was designated by the Patent and Trademark Office as “Invention II”. Accordingly, U.S. Patent No. 6,163,771, which includes only claims directed to subject matter designated by the Patent and Trademark Office as “Invention I,” cannot be used as a reference against any claims of the present divisional application that are consistent with the previously-restricted and non-elected Invention II.

35 U.S.C. § 121 states, in part:

A patent issuing on an application with respect to which a requirement for restriction under this section has been made, or on an application filed as a result of such a requirement, shall not be used as a reference either in the Patent and Trademark Office or in the courts against a divisional application or against the original application or any patent issued on either of them, if the divisional application is filed before the issuance of the patent on the other application.

Accordingly, Applicants respectfully submit that if:

- i) A requirement for restriction was made in Application No. 08/919,339;
- ii) The requirement for restriction was never withdrawn;
- iii) The present application was filed in response to the requirement for restriction;
- iv) The present application was filed before the issuance of U.S. Patent No. 6,163,771; and
- v) Pending Claims **16, 19, 23 and 25-27** are consonant with the restriction requirement in Application No. 08/919,339,

then a double patenting rejection of any of pending Claims **16, 19, 23 and 25-27** that relies on U.S. Patent No. 6,163,771 as a reference is prohibited under 35 U.S.C. § 121.

- A. A requirement for restriction was made in U.S. Patent Application No. 08/919,339, which issued as U.S. Patent No. 6,163,771

Claims 1-14, 16-71, and 19-29 of U.S. Patent Application No. 08/919,339 were subject to a requirement for restriction in an Office Action mailed July 20, 1999 (Paper No. 8), as being directed to two patentably distinct inventions. The Examiner considered Claims 1-14, 17, 20-22, 24, and 26-27 to be directed to “Invention I.” The Examiner considered Claims 16, 19, 23, 25,

and 28-29 to be directed to "Invention II." The Examiner required Applicants' election of either Invention I or Invention II.

In a Response mailed August 19, 1999, Applicants elected to prosecute the claims directed to Invention I, and cancelled all claims not directed to Invention I. The claims of the elected Invention I (Claims 1-14, 17, 20-22, 24, and 26-27) issued in U.S. Patent No. 6,163,771 (as Claims 1-21).

B. The requirement for restriction of Claims 16, 19, 23, 25, and 28-29 (Invention II) in U.S. Patent Application No. 08/919,339 was never withdrawn

C. The present application was filed in response to the requirement for restriction

In a Preliminary Amendment filed on April 3, 2000, with the present divisional application, Applicants stated: "The Examiner has issued a restriction requirement in the patent [sic] application, in response to which applicants have elected group I for prosecution. The applicants have filed this amendment to pursue claims, 16, 19, 23, 25, 28 and 29, representing the Examiner's group II."

[The Preliminary Amendment should have added new claims corresponding to Claims 28 and 29 of the parent application, and should not have referred to Claims 28 and 29 as being in the divisional application concurrently filed with the Preliminary Amendment.]

D. The present application was filed before the issuance of U.S. Patent No. 6,163,771

On April 3, 2000, and in response to the restriction requirement, Applicants filed the present divisional application, pursuing claims consistent with Invention II.

On December 19, 2000, U.S. Patent Application No. 08/919,339 issued as U.S. Patent No. 6,163,771.

E. Pending Claims 16, 19, 23, and 25-27 are consonant with the restriction requirement made in U.S. Patent Application No. 08/919,339

As stated in the Preliminary Amendment filed April 3, 2000, in the present application, Claims 16, 19, 23, and 25 were submitted as representing Invention II of U.S. Patent Application No. 08/919,339.

For the Examiner's convenience, a copy of Claims 16, 19, 23, 25, 28, and 29 of U.S. Patent Application No. 08/919,339 is attached, as those claims stood at the time of the restriction requirement (Paper No. 8).

Applicants respectfully submit that the pending Claims 16, 19, 23, 25, 26, and 27 are consistent with the previously-restricted and non-elected subject matter designated by the Patent and Trademark Office as Invention II: "drawn to verifying a second account identifier for use in place of the first account identifier." See Paper No. 8 in U.S. Patent Application No. 08/919,339. Pending Claims 16, 19, 23, 25, 26, and 27 are therefore consonant with the restriction requirement in U.S. Patent Application No. 08/919,339.

For example, at the time of the requirement for restriction, Claim 23 of U.S. Patent Application No. 08/919,339 was directed to "An apparatus for verifying a second account identifier for use in place of a first account identifier" (emphasis added), and recited a feature of:

- *a communications unit, connected to said processing unit, operable to transmit and receive information regarding a second account identifier*

Pending Claim 23 recites a feature of:

- *a communications unit, in communication with said processing unit, operable to transmit and receive information regarding a second account identifier for use in place of a first account identifier*

(emphasis added). All other claimed features of pending Claim 23 and of Claim 23 of U.S. Patent Application No. 08/919,339 are identical. Accordingly, Applicants respectfully submit that pending Claim 23 is consistent with the previously-restricted and non-elected subject matter designated by the Patent and Trademark Office as Invention II.

Applicants respectfully submit that similar comparisons between pending Claims 16, 19, 25, 26, and 27, and Claims 16, 19, 25, 28, and 29, respectively, of U.S. Patent Application No. 08/919,339, establish that although not identical to claims of U.S. Patent Application No. 08/919,339, all of the pending Claims 16, 19, 23, 25, and 26-27 are consistent with the previously-restricted and non-elected subject matter designated as Invention II in U.S. Patent Application No. 08/919,339. Accordingly, the line of demarcation between Inventions I and II that was identified by the Patent and Trademark Office in the requirement for restriction has been maintained. See MPEP § 804.01.

All of pending Claims 16, 19, 23, and 25-27, therefore, are consonant with the restriction requirement in U.S. Patent Application No. 08/919,339.

Accordingly, the Examiner is prohibited under 35 U.S.C. § 121 from relying on U.S. Patent No. 6,163,771 as a reference for a double patenting rejection of any of pending Claims 16, 19, 23, and 25-27. Applicants respectfully request the Examiner's reconsideration of the double patenting rejection of Claims 23 and 25.

Claims 16 and 19 Are Allowable

During a telephone conversation held on August 13, 2002, the Examiner explained that the obviousness-type double patenting rejection of Claims 16 and 19 has been withdrawn. Applicants are grateful for the Examiner's re-consideration of Claims 16 and 19 and for the Examiner's courtesy in contacting Applicants in order to expedite prosecution.

Applicants respectfully submit that Claims 16 and 19 are in condition for allowance.

New Claims 28-44 Are Allowable

Each of new Claims 28-44 is dependent from independent Claim 19. Applicants respectfully submit that new Claims 28-44 contain allowable subject matter, for at least the reasons stated herein with respect to independent Claim 19.

Conclusion


It is submitted that all of the claims are in condition for allowance. The Examiner's early re-examination and reconsideration are respectfully requested.

Please charge any fees that may be required for this Amendment to Deposit Account No. 50-0271. Furthermore, should an extension of time be required, please grant any extension of time which may be required to make this Amendment timely, and please charge any fee for such an extension to Deposit Account No. 50-0271.

If the Examiner has any questions regarding this amendment or the present application, the Examiner is cordially requested to contact Michael Downs at telephone number (203) 461-7292 or via electronic mail at mtdowns@walkerdigital.com.

Respectfully submitted,

October 8, 2002
Date



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A M E N D M E N T**Marked-Up Version**

Please amend the above-specified application as follows:

IN THE SPECIFICATION:

Please **REPLACE** the paragraph starting at page 17, line 26 as follows:

To verify the card number, the credit card issuer's central processor first extracts the encrypted nonce C, the initialization variable IV, and account number A from the credit card number (step 902). The processor then retrieves the extracted account number from the cardholder account database 411 (step 903), and determines whether the account number is valid (step 904). If the account number is not valid, the transaction is aborted (step 905). If the account number is valid, the processor looks up the account number in the credit card transaction database 413 to determine whether the card holder has previously used the initialization variable IV (step 906). If the cardholder has done so, the transaction is aborted (step [908] 907). If the initialization variable has not been used, the incremented initialization variable is stored in the credit card transaction database 413 (step 908).

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IN THE CLAIMS:

Please **AMEND** Claims **16 and 19** as follows:

16. (TWICE AMENDED) An apparatus, comprising:
- a processing unit, said processing unit including a cryptographic processor;
 - a communications unit, in communication with said processing unit, operable to transmit and receive information regarding a second account identifier for use in place of a first account identifier; and
 - a memory device connected to said processing unit, said memory device containing
 - a private cryptographic key,
 - a first data element,
 - a second data element and
 - a program, adapted to be executed by said processing unit, to
 - receive the second account identifier,
 - extract from the second account identifier a third data element and a fourth data element,
 - decrypt the third data element using the private cryptographic key and the fourth element,
 - compare the decrypted third data element with the first data element in a first comparison,
 - compare the fourth data key element with the second data element in a second comparison, and
 - verify the second [financial] account identifier in accordance with the first comparison and the second comparison.
19. (TWICE AMENDED) A method, comprising the steps of:
- providing a memory device containing a private cryptographic key, a first data element and a second data element;
 - receiving a second account identifier for use in place of a first account identifier;
 - extracting from the second account identifier a third data element and a fourth data element;
 - decrypting the third data element using the private cryptographic key and the fourth data element;
 - comparing the decrypted third data element with the first data element in a first comparison;
 - comparing the fourth data element with the second data element in a second comparison;
 - and
 - verifying the second [financial] account identifier in accordance with the first comparison and the second comparison.